

S/N 10/750,279



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Pak-Lung Seto
Serial No.: 10/750,279
Filed: December 31, 2003
Title: COMMUNICATION CONTROL

Examiner: Christopher B. Shin
Group Art Unit: 2681
Docket No.: 32607.P17727

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant has reviewed the Office Action mailed on August 11, 2006 and requests review of the final rejection in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

As this Request and the Notice of Appeal are being filed within the three month shortened statutory period for reply, no extension of time is believed necessary. However, Applicants conditionally petition for any necessary extension of time to provide for the possibility that the need for such an extension has inadvertently been overlooked. Please charge our Deposit Account No. 50-2121 for any required extension of time.

REMARKS

The pre-appeal brief review is requested for the reasons stated below.

I. The Office erred by maintaining a rejection under 35 U.S.C. 103 after applicant established that the Beckett reference should be disqualified as prior art under 35 U.S.C. 103(c)

The Office Action maintained the rejection of claims 5-8 and 13-17 under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication 2005/0066100 to *Elliott et al.* ("Elliott") in view of U.S. Publication 2005/0149793 to *Beckett, et al.* ("Beckett"). In the Amendment and Response under 37 CFR 1.111 filed by applicant on May 1, 2006 (hereinafter the "Response") on page 11, lines 16-17, applicant pointed out that Beckett should be disqualified as prior art under 35 U.S.C. 103(c). On page 11, lines 19-21, the Response included a statement that "the subject matter of Beckett and the claimed invention were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to Intel Corporation." The final Office Action failed to address this issue. Thus, the Office clearly erred by maintaining the rejection under 35 U.S.C. 103(a) over Elliott in view of the disqualified reference, Beckett.

II. The Office erred by applying the wrong standard for interpretation of the claims

In the Response to Arguments section (2.b.), the Office Action states that "the examiner gives a broadest possible reasonable interpretation." Applicant respectfully submits that this misstates the standard for claim interpretation that must be applied by the Office. "During patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.'" *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); see also, MPEP 2111.

In the Response on page 8, lines 3-6, the applicant suggests the proper meaning of the term "selectable communications control" consistent with the specification. The Office Action states that the examiner traverses this interpretation by applicant but fails to explain why applicant's interpretation is improper and fails to explain the actual interpretation applied by the examiner. After stating the improper standard for claim interpretation, the Office Action merely concludes that the "claimed 'selectable communication control' clearly reads on the functional

teachings of (240 &217) of Elliott reference." Thus, the Office has clearly erred by applying the wrong standard for interpretation of the claims.

III. The Office erred by failing to provide an adequate explanation to support the rejection under 35 U.S.C. 102(e)

The Office Action maintained the rejection of claims 1-3, 9 and 18 under 35 U.S.C. 102(e) as being anticipated by Elliott and appears to rely on principles of inherency. Applicant notes that the previous Office Action had asserted that these claimed elements and limitations were "obvious features" of various devices in Elliott. In response to applicant's argument that the Office Action appeared to improperly rely on obviousness to reject claims under 35 U.S.C. 102, the Office has merely deleted the term "obvious" from the Office Action. The Office Action still does not provide a sufficient explanation of how the claimed elements and limitations are present in the system disclosed by Elliott to support a *prima facie* rejection based on anticipation.

As described in detail in the Response on page 8, line 8, to page 9, line 30, Elliott does not disclose the "selectable communications control" recited in claim 1, "restricting access" recited in dependent claim 2, or "designating a zone" recited in dependent claims 9 and 18. In explaining the rejection, the Office Action merely refers to reference numerals (e.g., 217 and 240) in Elliott and concludes that the claimed limitation "clearly reads on the functional teachings of (240 & 217) of Elliott reference." "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office Action fails to provide any such basis in fact or technical reasoning. Thus, the Office has clearly erred in applying the principles of inherency to this anticipation rejection.

IV. The Office erred by failing to provide adequate motivation to support the rejection under 35 U.S.C. 103

The Office Action maintained the rejection of claims 4, 10-12 and 19-21 under 35 U.S.C. 103(a) over Elliott. The Office Action does not combine any other reference with Elliott to

establish obviousness of these claims and appears to rely on the missing elements and limitations as being well known. The Office Action fails to explain the motivation that is necessary to establish a *prima facie* rejection based on obviousness.

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP 2143.01. With respect to claim 4, the Office Action states that “Elliott does not expressly disclose the limitations regarding allocating bandwidth; however, such limitation is inherent characteristics of Elliott’s system” and concludes “it would have been obvious at the time the invention was made to one having ordinary skill in the art to come up with the claimed invention form [sic] the Elliott’s system.” With respect to claims 10-12, the Office Action states “the limitations regarding restricting access is an [sic] well known commonly utilized functions of any multiple device communication system such as the Elliott system.” These conclusory statements made in the Office Action do not adequately explain how there is motivation, either explicitly or implicitly, to modify Elliott, as discussed in the Response on page 10, lines 15-18 and 24-30.

In response to applicant’s arguments made in the Response, instead of explaining the motivation, the Office Action merely states “the above limitations are basic necessary part of the functional operation of Elliott reference. Clearly, one skilled in the artisan [sic] knows that the bandwidth is allocated and that the communication is selectively controlled in the routing controller.” Applicant submits that “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697; See also MPEP 2144.03. Thus, the Office has clearly erred by failing to provide any explanation of how one skilled in the art would be motivated to modify the Elliott reference.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant’s attorney (603-668-6560) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-2121.

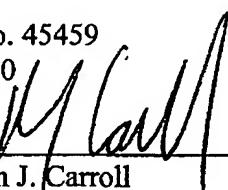
Respectfully submitted,

PAK-LUNG SETO

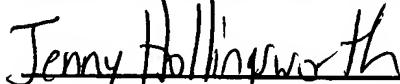
By his Representatives,

Customer No. 45459
603-668-6560

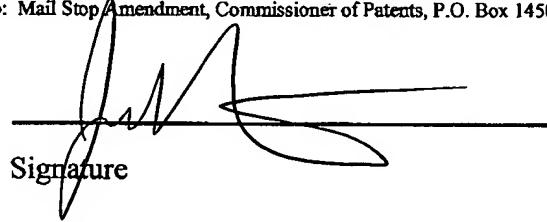
Date 11/13/06

By 
Kevin J. Carroll
Reg. No. 36,384

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of 2006.



Jenny Hollingsworth



Signature